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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,754	07/12/2006	Marc Karel Jozef Francois	PRD2166USPCT	1592

27777 7590 11/23/2009  
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EXAMINER
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MILLIGAN, ADAM C

ART UNIT	PAPER NUMBER
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1612

MAIL DATE	DELIVERY MODE
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11/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,754	<b>Applicant(s)</b> FRANCOIS ET AL.	
	<b>Examiner</b> ADAM MILLIGAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Applicants' arguments, filed 6/30/2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

**Claims 1-12** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heeres (WO 96/13499- See IDS dated 7/12/2006) in view of Chen (2002/0147201) and Basit et al. (The Effect of Polyethylene Glycol 400 on Gastrointestinal Transit: Implications for the Formation of Poorly Water Soluble Drugs, Pharmaceutical Research, Volume 18, No. 8, 2001).

Applicants argue that the prior art does not read on the instant claims because the prior art teaches an aqueous solution, whereas the instant claims are drawn to an oral solution. Applicants then argue that Chen does not teach that polyethylene glycol (PEG) should be incorporated into the solution for the purpose of increasing solubility. Applicants then argue that the mitratapide solutions of the present invention are not aqueous solutions, but instead use an organic solvent. Applicants state that claim 1 has been amended to include solvents of claim 2 in order to clarify this point. Finally, Applicant argue that the composition rendered obvious by the prior art would result in an

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aqueous solution of mitratapide complexed with glycyrrhizin, and therefore the prior art does not render the instant invention obvious.

Examiner disagrees. First, in response to applicant's assertion that the composition made obvious is not an oral solution, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, there are multiple oral formulations disclosed which may include the various active ingredients (See pp. 26-27, examples 8-10). Note, even parenteral compositions maybe administered orally where the solution is aqueous and aqueous solutions are generally accepted as orally acceptable.

Second, the teachings of Chen was not relied upon for the teaching directed to the addition of PEG-400 to the composition taught by Heeres. Basit was relied upon for the teaching that the addition of PEG-400 would enhance the solubility and bioavailability of poorly water-soluble drugs, as discussed in the Office Action dated 03/30/09. Thus, it would have been obvious to one of ordinary skill in the art to incorporate PEG-400 into the mitratapide composition taught by Heeres, because Heeres teaches that other ingredients may be included to aide in solubility and Basit teaches that the addition of PEG-400 will enhance the solubility and bioavailability of poorly water-soluble drugs (i.e. mitratapide). Chen then teaches the importance of having a preferable taste and the addition of antioxidants used to stabilize compositions.

Third, while the amendment is acknowledged, it does not overcome the rejection. Though the term "solvent" is now limited to the Markush grouping, the entire solution is modified by the transition "comprising" allows additional solvents in addition to those of the Markush grouping. Therefore, the inclusion of any solvent system with includes a solvent from the Markush grouping meets the recited limitation, even if additional solvents are present. Here, it has been demonstrated above that it would have been obvious to the skilled artisan to add PEG-400, one of the solvents instantly claimed, to the mitratapide composition taught by Heeres in order to increase the mitratapide solubility and bioavailability, as taught by Basit, which may include additional solvents.

Finally, with regards to the combination of teachings resulting in a drug complex, the skilled artisan would not rely upon only WO-96/13499 and US2002/0147201 before moving on to the additional art cited. Note, the above stated rejection is not the claims are obvious in light of the first two pieces of prior art, the combination further in view of the tertiary art, but instead the instant claims are obvious over the primary art in view of the two secondary pieces of prior art. As such, Examiner asserts the skilled artisan would look to WO-96/13499, and then look to other art for a means of overcoming the solubility problem, such as disclosed in Basit et al, where solubility is a problem with the drug, as taught by US2002/0147201. Thus, the skilled artisan need not be use a drug complex to overcome the solubility issue, but would find it obvious to use the solubility enhancing agents of Basit et al, and relying on US2002/0147201 for additional agents which may stabilize the composition and the teaching of the solubility problem of the active agent.

***Conclusion***

No claims allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM MILLIGAN whose telephone number is (571)270-7674. The examiner can normally be reached on M-F 9:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fred Krass can be reached on (571)272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612

/A. M./  
Examiner, Art Unit 1612